



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,301	01/13/2006	Atsushi Kikuchi	Q87762	5170
23373 7590 09/15/2009 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			EXAMINER AUGHENBAUGH, WALTER	
			ART UNIT 1794	PAPER NUMBER
			MAIL DATE 09/15/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/533,301

Applicant(s)

KIKUCHI ET AL.

Examiner

WALTER B. AUGHENBAUGH

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 July 2009 and 01 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 6-8 is/are pending in the application.
- 4a) Of the above claim(s) 6-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 31, 2009 has been entered.

Acknowledgement of Applicant's Amendments

2. Applicant's amendments in claim 1 in the Amendment filed July 31, 2009 have been received and considered by Examiner.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The exact structure that Applicant intends to recite by the recitation "including body and bottom portions having a continuous multi-layer structure formed by compression-forming a molten resin mass and continuously forming a multi-layer structure in the body portion and in the body portion thereof" cannot be ascertained.

It is unclear from the claim language what the nature of the "continuous multi-layer structure" is. In other words, the structural relationship between the "body and bottom portions"

with regard to the recited “continuous multi-layer structure” cannot be ascertained. It is further unclear whether or not “continuous” positively recites any structural relationship between the “body and bottom portions”.

The recitation “continuously forming a multi-layer structure in the body portion and in the body portion thereof” further renders the structural limitations Applicant intends to recite unclear because “continuously forming” reads as a method limitation that does not appear to positively recite a structural limitation (“continuously forming” as in continuously through time, as opposed something being continuous through space).

The recitation “structure in the body portion and in the body portion thereof” further renders the structural limitations Applicant intends to recite unclear. What is the “body portion thereof” a component of? Are “the body portion” and “the body portion thereof” two different components of the preform as this claim language appears to imply? Or is “the body portion thereof” a portion of “the body portion”? How are there two different body portions? What are they?

Claim Rejections - 35 USC § 102

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
6. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamada et al. (USPN 4,528,219).

In regard to claim 1, Yamada et al. teach a multilayer preform that corresponds to the preform claimed in claim 1 comprising layers of a polyester resin that contains ethylene terephthalate units (PET) as inner and outer layers and either a gas barrier resin layer or a

recycled polyester resin as an intermediate layer (col. 11, lines 22-60). This structure is also more generally taught, for example, at col. 6, line 59-col. 7, line 14. Yamada et al. teach that the multilayer preform is formed by compression molding (which is compression forming) (col. 11, lines 47-51 and col. 7, lines 4-14). The time is not shorter than 300 seconds before a calorific value of isothermal crystallization of the layer of the polyester resin of the preform of Yamada et al. at 210°C reaches a maximum value because Yamada et al. teach a preform that meets the structural and compositional limitations of the claim. The preform of Yamada et al. has “a continuous multi-layer structure formed by compression-forming a molten resin mass and continuously forming a multi-layer structure in the body portion and in the body portion thereof” because the re-heated pipe taught at col. 11, lines 47-49 and at col. 7, lines 4-14 is a “molten resin mass” because it is a re-heated resin pipe, and because the walls of the body are continuous. The resin pipe is a resin mass because it consists of resin.

In regard to claim 2, the polyester resin contains ethylene terephthalate units in an amount of 100%, which is more than 95% (col. 11, lines 22-25 and lines 41-60).

In regard to claim 3, recycled polyester resins fall within the scope of the teaching of Yamada et al. of PET (col. 7, lines 34-38). For example, recycled polyethylene terephthalate is polyethylene terephthalate.

Response to Arguments

7. Applicant's arguments on pages 4-6 of the Amendment regarding the 35 U.S.C. 102 rejection of claims 1-3 (and prior claims 4 and 5) have been fully considered but are not persuasive.

Applicant's arguments on pages 4-6 of the Amendment are largely based on differences in the method of producing the product of the prior art and Applicant's method of producing Applicant's product. However, Applicant has not shown that Applicant's process of forming Applicant's product results in distinctive structural characteristics of the final product as compared to the preform of Yamada et al. MPEP 2113. Applicant has not provided evidence that shows that Applicant's process of forming Applicant's product results in distinctive structural characteristics of the final product as compared to the preform of Yamada et al. The arguments of counsel cannot take the place of evidence in the record. MPEP 716.01(c)II.

Applicant appears to argue on page 4 of the Amdt. that the compression molded preform of Yamada et al. is structurally different from the claimed preform because the ends of the pipe used to form the preform are reheated, and both end portions are compressed. However, Applicant has not explained or shown how the process of Yamada et al. is different from the compression forming process of claim 1, or how the the compression molded preform of Yamada et al. is structurally different from the claimed preform. The arguments of counsel cannot take the place of evidence in the record. MPEP 716.01(c)II.

Applicant appears to argue on page 5 of the Amdt. that the multilayer structure "continues in the bottom portion thereof", and the multilayer structure of Yamada et al. does not continue "in the bottom portion": while there is some indefiniteness in regard to the structure Applicant intends to recite in claim 1 (see 35 USC 112, second paragraph, rejection of claim 1 made of record in this Office Action), Applicant has not convincingly explained or shown how the multilayer structure of Yamada et al. does not continue "in the bottom portion" of the

preform. The arguments of counsel cannot take the place of evidence in the record. MPEP 716.01(c)II.

Applicant argues on page 5 of the Amdt. that the multilayer structure of Yamada et al. does not continue “through the bottom portion” of the preform, but Applicant has not convincingly explained or shown how the multilayer structure of Yamada et al. does not continue “through the bottom portion” of the preform. The arguments of counsel cannot take the place of evidence in the record. MPEP 716.01(c)II. Furthermore, the claim language does not appear to require that the multilayer structure continue “through the bottom portion” of the preform as Applicant appears to argue.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B. Aughenbaugh whose telephone number is (571) 272-1488. The examiner can normally be reached on Monday-Thursday from 9:00am to 7:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Rena Dye, can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Walter B Aughenbaugh /
Examiner, Art Unit 1794

9/10/09